

Attorney's Docket: 2000DE135
Serial No.: 10/004,601
Art Unit: 1756

REMARKS

The Office Action mailed October 8, 2003, has been carefully considered. The amendments and remarks presented herein are believed to be fully responsive to the Office Action. The amendments made herein are fully supported by the Application as originally filed. No new matter has been introduced. Accordingly, reconsideration of the present Application in view of the above amendments and following remarks is respectfully requested.

Claim Status

Claims 1-16 and 18-21 are pending in this Application. By this Amendment, Applicants have amended claims 1, and 18-20, and have cancelled claim 17.

Claim Rejections Under 35 USC § 112, First Paragraph

Claims 1-16 and 18-21 stand rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. The Office states that "the specification as filed does not provide basis for the claims as currently presented because the specification states that the wax coated pigment granules are homogeneously incorporated into the binder when the toner is prepared by an adding, grinding and classifying process". This rejection is respectfully overcome.

Independent claim 1 has been amended, deleting the phrase "adding to a binder resin" and in its stead the language "homogeneously incorporating spherically shaped wax coated pigment granules into a binder resin" has been added.

Concerning claims 18 and 19, such claims have been amended to recite that the homogeneously incorporating step further comprises kneading (claim 18), and extruding (claim 19), the binder resin and the wax coated pigment granules.

In view of the foregoing, it is courteously believed that the 35 USC § 112, first paragraph rejection has been overcome.

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Claim Rejections Under 35 USC § 112, Second Paragraph

Claims 18-20 stand rejected under 35 USC § 112, second paragraph as being indefinite. Specifically, the Office states that claims 18-20 are Indefinite because it is unclear what the binder resin and the wax coated pigment are incorporated into. Claim 20 stands indefinite because there is no antecedent basis for the phrase "during the polymerization process". This rejection is respectfully overcome.

With respect to claims 18 and 19, such claims have been amended to specify that the step of kneading and extruding the binder resin and the wax coated pigment granules are further limitations of the incorporating step.

Claim 20 has been amended to recite that the incorporating step further comprises adding the coated pigment granules to binder resin during polymerization of the binder resin.

In view of the foregoing, it is respectfully contended that the 35 USC § 112, second paragraph rejection has been overcome.

Claim Rejections Under 35 USC § 103

Claims 1-3, 5-10, 12-16, 18, 19 and 21 stand rejected under 35 USC § 103(a) as being unpatentable over *Handbook of Imaging Materials* to Diamond, pp. 162-171 & 193-197 in view of Pollard in US Patent 4,173,492, and further in view of JP 3-168760. This rejection is respectfully overcome.

Independent claim 1 has been amended to recite a method for coloring a composition wherein spherically shaped wax coated pigment granules are homogeneously incorporated into a binder resin.

The prior art cited by the Office does not teach, disclose, or suggest the use of spherically shaped wax coated pigment granules. As stated by the Office, Pollard in column 6, lines 21-23 discloses:

The hydroxystearate wax encapsulates the particles to produce a flake which includes encapsulated pigment particles and coating wax. The pigments are

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well dispersed through the wax and the resulting product is a flake or chip that is substantially larger than individual pigment particles.

It is well settled that a § 103 rejection requires the reference, or reference combination, to disclose each and every element of a claim. Here, the prior art does not in any way teach, disclose, or suggest the use of spherically shaped wax coated pigment granules.

Furthermore, it would not be obvious to an ordinary artisan with a knowledge of Pollard, Diamond and JP 3-168760 to contemplate employing spherically shaped wax coated pigment granules. Indeed, one with ordinary skill would to be required to abandon the teachings of Pollard before the prospect of spherically shaped particles could be entertained. This is so because Pollard repeatedly states that the particles are flakes. See, *inter alia*, column 3, lines 6, 9 and 10; column 5, lines 23-25, col. 9, lines 58-60; and col. 10, line 37. As the prior art is incapable of providing one with ordinary skill with the motivation necessary to arrive at the present invention, it is Applicants' respectful position that such motivation is derived from hindsight based on a knowledge of Applicants' disclosure. In consequence, Applicants contend that claim 1, as amended, and all claims depending therefrom, are not made obvious by any combination of Diamond, Pollard, and JP 3-168760.

In view of the foregoing, Applicants respectfully request reconsideration withdrawal of the § 103 rejection.

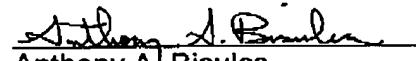
In the Advisory Action mailed June 2, 2003, the Office stated that two references submitted with the After Final Response had been considered. The Office requested that Applicants supply a new 1449 listing those two references. Attached herewith is the 1449 requested.

As the total number of claims does not exceed the number of claims originally paid for, no fee is believed due. However if an additional fee is required, the Commissioner is hereby authorized to credit any overpayment or charge any fee deficiency to Deposit Account No. 03-2060.

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In view of the forgoing amendments and remarks, the present application is believed to be in condition for allowance, and reconsideration of it is requested. If the Examiner disagrees, he is requested to contact the attorney for Applicants at the telephone number provided below.

Respectfully submitted,


Anthony A. Bisulca
Attorney for Applicant
Registration No. 40,913

(CUSTOMER NUMBER 25,255)

Clariant Corporation
Industrial Property Department
4000 Monroe Road
Charlotte, NC 28205
Phone 704 331-7151
Fax 704 331-7707